



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,135	06/27/2003	Brett G. Clark	006203.00011	5566
22907	7590	01/19/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			SEMBER, THOMAS M	
		ART UNIT	PAPER NUMBER	
			2875	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/607,135	CLARK, BRETT G.	
	Examiner	Art Unit	
	Thomas M. Sember	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 November 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,8,10-15,22,23 and 25-34 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 10-15,22,23,25-27 and 34 is/are allowed.
 6) Claim(s) 1-5,8 and 31-33 is/are rejected.
 7) Claim(s) 20 and 29 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It has been held that the presence of a trademark in a claim renders the latter indefinite under 35 USC 112,2d para. See *Ex parte Simpson et al.*, 218 USPQ 1020; *Ex parte Wellington*, 1904 CD 564.

As best understood the following prior art rejections apply:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Holland. Holland discloses an exterior wall including an opening, the exterior wall defining an at least substantially enclosed volume, the volume including a first volume portion 17 and a second volume portion 19 physically divided from the first volume portion by a wall 12, the first volume portion 17 being sufficient to hold at least a

portion of the product (this limitation is intended use and the volume only has to be capable of holding a product, regardless the carrier holds Halloween candy which is a product); and a light source 18 is configured to direct light inside the second volume portion 19, the light being emitted through the opening (light is directed out of the bottom of the bucket). As broadly claimed, the opening has a shape that can be associated with the product.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, 8 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Demmery. Demmery discloses an exterior wall including an opening, the exterior wall defining an at least substantially enclosed volume, the volume including a first volume portion 11 and a second volume portion 17 physically divided from the first volume portion by a wall 24, the first volume portion 11 being sufficient to hold at least a portion of the product (this limitation is intended use and the volume only has to be capable of holding a product, regardless the carrier holds Halloween candy which is a product); and a light source 22 is configured to direct light inside the second volume portion 17, the light being emitted through the opening (light is directed out of the bottom of the bucket). A transparent and opaque lens is disposed

within the opening (light strikes diffuser 18 and some light is reflected and some light is transmitted through). As broadly claimed, the opening has a shape that can be associated with the product.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Scholz. Scholz discloses an exterior wall 11 including an opening 23, the exterior wall defining an at least a substantially enclosed volume, the volume including a first volume portion 14 and a second volume 23 portion physically divided (17a) from the first volume portion, the first volume portion being sufficient to hold at least a portion of the product (intended use); and a light source 25 configured to direct light inside the second volume portion (area close to detail 23), the light being emitted through the opening. The opening having light permeable covers 23. Outside portion 11 is opaque. 5. The second volume portion includes a cavity defined by a wall dividing the second volume portion from the first volume portion, the wall having a reflective surface on a side of the wall facing the cavity. As broadly claimed, the opening has a shape that can be associated with the product.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over (Demmery or Holland) in view of O'Rourke et al. (Demmery or Holland) discloses the claimed invention except for the teaching that the light source is an LED. O'Rourke using an LED light to illuminate a football. It would have been obvious to one skilled in the art at the time the invention was made to substitute an LED light source as taught by O'Rourke for the low voltage light source of (Demmery or Holland) in order to provide an alternatively effective low voltage light that last longer and is more efficient than most conventional low voltage light sources.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over (O'Rourke et al or Demmery or Holland) in view of Bell. (O'Rourke or Demmery or Holland) discloses the claimed invention except for the teaching that the light source blinks. Bell teaches a blinking product box. It would have been obvious to one skilled in the art at the time the invention was made to modify the light sources of (Demmery or Holland) to include a blinking circuit as taught by Bell in order to effectively get the attention of the people in the area.

Response to Arguments

8. Applicant's arguments filed on 11/17/2005 have been fully considered but they are not persuasive. The applicant argues that Holland et al, Demmery and Sholz fail to teach or fairly suggest that the opening has a shape that can be associated with the product. The examiner disagrees because this is a functional limitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Thus, since the openings of the prior art references of Demmery, Holland et al and Sholz are capable of being associated with a product, the prior art references meet this claimed limitation.

Applicant's arguments with regard to claims 10-15, 22-23, 25-27 and 34 are found persuasive.

Allowable Subject Matter

9. Claims 10-15, 22-23, 25-27 and 34 allowed.
10. Claims 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2875

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas M Sember
Primary Examiner
Art Unit 2875
